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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,277	07/09/2001	Osamu Nagata	7217/64520	7556

7590 08/20/2003

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1185 Avenue of the Americas
New York, NY 10036

EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

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DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,277

Applicant(s)

NAGATA ET AL.

Examiner

Aristotelis M Psitos

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) all is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2653

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 6/24/03 and 5/115/03 have been entered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As now recited, lines 3-4 recite limitations not readily found in the specification as originally filed. Applicants' cooperation is respectfully requested in further explaining where such support exists. The dependent claim fails to clarify the above and falls with its' parent claim.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1 and 33 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. In particular, as amended lines 3-4 recite limitations of a relationship of the recordable time of the present claimed record medium with that of the source medium(s). Such a relationship is not of a limiting nature because no such relationship is found/contained in the remaining language of the product being claimed. Hence NO WEIGHT IS GIVEN TO SUCH LIMITATIONS IN THE FOLLOWING ART REJECTIONS.

Art Unit: 2653

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiranuma further considered with either EP 655740 or Yokota et al and all further considered with Matsumoto et al.

Hiranuma discloses in a dubbing system the ability of having a source and a copy. The source being from in CD format and the copy being in MD format (i.e., from one type of recording to another).

Furthermore, the reference has a program recording area and management data area – the U & P- TOCs for instance. The U-Toc records management data such as title, range (first and last tnos) as well as (additional information).

Art Unit: 2653

With respect to the ability of having a plurality of source mediums, although Hiranuma et al provides for a single source medium, the ability of having a plurality of source media is considered merely a duplication/multiplication ability. That is, recording onto a copy record from a plurality of sources is considered merely duplicating the effect of dubbing.

The examiner interprets the ability of having separate management data areas, one for positioning information and the other for the group names, etc., as inherently present in the above system. Alternatively if applicants' can convince the examiner that such is not inherently present then the examiner would further rely upon either the EP document note for instance page 17 lines 17 plus which provides both a directory and a file name as well as size information and index information. The ability of placing management data into a plurality of managing data areas is considered an obvious expedience.

Analogous, Yokota et also provide for files/groups as well as range information – see figures 3 and 4 which also depict both start and end tn. and range information.

The documents fail to specify any separating information.

The use of "separating" information so as to permit such is well known in this environment as taught by the Matsumoto et al system.

It would have been obvious to modify the base system of the references as relied upon above with the additional teaching from Matsumoto et al motivation is to separate the information as taught by the Matsumoto et al document.

With respect to claim 33, the separation is performed for all data fields and hence this limitation is present in the above combined teachings.

9. Claims 1 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takaku et al further considered with either EP 655740 or Yokota et al and all further considered with Matsumoto et al.

Takaku et al disclose a dubbing system wherein a plurality of source media and a copy medium are provided. Since the copy medium as well as a source medium is a MD, appropriate TOC data area must be inherently present. There is no further delineation of the TOC management areas.

The EP document provides for both director and file management data areas as well as the standard size and track number information as well.

Art Unit: 2653

Alternatively, Yokota et al et al also discloses the ability of having names for the files/groups as well as range information, start and stop track number and range information –see figures 3 & 4.

It would have been obvious to modify the base system of Takaku et al with the above teaching from either the EP document or Yokota et al in order to have separate management data area each for selective management data, because such is considered a design expediency.

Finally, there is no separation data specified in these documents. Nevertheless, such information formatting is well known in this environment as taught by the Matsumoto et al document.

It would have been obvious to modify the base system of Takaku et al with the above additional teachings from Matsumoto et al for the separation ability for the inherent advancement as discussed in Matsumoto et al.

With respect to the limitations of claim 33, the separation teaching from Matsumoto et al applies equally as well as to all data information.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Either Scheffler system can be relied upon in place of the primary references used above in the 103 rejections for disclosing a dubbing/copying system from plural source media to a single copy medium. Igarashi et al also teaches plural data management areas. Yoshida et al is cited as another management data area for linking various files including positioning information etc.

Docket et al is cited as illustrative of a custom CD system.

Goto is cited as illustrative of md recording systems using a single source

Hard copies of the application files are now separated from this examining corps, hence the examiner can answer no questions that requires a review of the file without sufficient lead-time.

Any inquiries concerning missing papers/references, etc. must be directed to Group 2600 Customer Services at (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

Application/Control Number: 09/901,277

Page 6

Art Unit: 2653

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Aristotelis M Psitos
Primary Examiner
Art Unit 2653

A handwritten signature in black ink, appearing to be 'A. Psitos', written over a horizontal line.

AMP
18 August 2003